



USG3368

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

USG3368

In re Application of: THOMAS G.)
HOUMAN, RICHARD B. STEVENS,)
THERESA A. FULTS and TIMOTHY G.)
KENNY)

Serial No. 09/716,392

Filed: NOVEMBER 20, 2000

For: ABUSE RESISTANT SKIM COATING COMPOSITION

Examiner: CALLIE E. SHOSHO

Art Unit: 1714

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

AMENDMENT B

Responsive to the Office Action dated October 17, 2002, applicants are presenting the SECOND DECLARATION OF RICHARD STEVENS

In Office Action dated October 17, 2002, the Examiner stated that all of the rejections set forth in the first Office Action were overcome by applicants' submission of August 5, 2002, but she has rejected all pending claims as obvious under 35 USC §103 based on the US Patent 6,063,472 to Takaoka et al in view of US Patent 6,180,037 to Anderson et al.

At page 3 of the Office Action, the Examiner admitted that Takaoka et al does not disclose the number of aggregate particles per square inch that is required by applicants' claims. More importantly, however, Takaoka et al fails to disclose the specific particle size range for the aggregate required by all of applicants' claims. It is submitted that it would be clear to those skilled in the art that the number of aggregate particles per square inch is necessarily dependent upon the aggregate particle size range. As is taught by applicants' specification, the particle size of the aggregate must be within the ranges specified by the applicants' claims in order to achieve the self-gauging property that characterizes applicants' invention. Specifically, applicants' claims require the aggregate to "consist of" of at least 90% of particles passing a 30 mesh screen and at least 90% particles retained on a 50 mesh screen. The use of an aggregate in this size range enables applicants' compositions to form a layer of aggregate particles from about 0.020 to 0.050 inches (510 to 1270 microns) thick. The layer of particles of the specified thickness provides applicants' composition with the self-gauging property.

Takaoka et al does not disclose the particle size range required by applicants' claims. Takaoka et al discloses aggregates having an average particle size of from 0.03 to 2 mm (Col. 5, lines 10). Takaoka et al provides no suggestion of using an aggregate that is within the specific particle size limits of applicants' claims.

The Takaoka et al patent presents 21 examples most of which include as the "aggregate" a very finely divided calcium carbonate. Takaoka et al describes

the calcium carbonate as having an average particle diameter of 40 microns (Col 14, line 4), which is well outside the 0.020 to 0.050 inch (510 to 1270 microns) range required by applicants' claims. The Takaoka et al patent also presents 5 examples (e.g. examples 5, and 14) of compositions that employ a finely divided silica sand aggregate. Takaoka et al describes the silica sand as having average diameter of 120 microns (Col. 14, line 6), which is also outside the range specified by applicants' claims. Only examples 10 and 11 of the Takaoka et al patent present compositions that employ an aggregate within the 0.020 to 0.050 inch (510 to 1270 microns) range required by applicants' claims. The compositions of examples 10 and 11 use as a mica aggregate having an average particle size of 700 microns (See Col. 14, lines 7-8).

Applicants are presenting the SECOND DECLARATION OF RICHARD STEVENS which sets forth the laboratory duplication and testing of Example 10 of the Takaoka et al patent. Mr. Stevens found that the Takaoka et al example did not provide any sort of self-gauging property and that it had inferior abuse resistance when measured by the tests described in applicant's specification. It is submitted that the Declaration provides compelling evidence that Takaoka et al fails to make obvious the aggregate required by all of applicants' claims.

US Patent 6,180,037 to Anderson et al, cited as the secondary reference, was cited to show that particle packing impacts on the workability of a composition. However, Anderson et al fails to disclose the aggregate required by applicants' claims. Moreover, Anderson et al contains no suggestion as to how to produce a self-gauging composition. Specifically, Anderson et al fails to

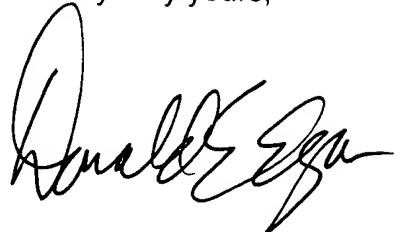
disclose an aggregate to "consisting of" of at least 90% of particles passing a 30 mesh screen and at least 90% particles retained on a 50 mesh screen. The aggregate in this size range enables applicants' compositions to form a layer of aggregate particles from about 0.020 to 0.050 inches (510 to 1270 microns) thick. The layer of particles of the specified thickness provides applicants' composition with the self-gauging property. None of these are disclosed or made obvious by Anderson et al. Accordingly the prior art combination of US Patent 6,063,472 to Takaoka et al in view of US Patent 6,180,037 to Anderson et al fails to make obvious applicants invention or any of applicants' claims.

In Amendment A applicants' argued that Takaoka et al does not disclose a self-gauging coating composition having improved abuse resistance, but that it al describes an architectural material produced by applying a decorative "kneaded mixture" (see Example 1) composition to a substrate such as a board in a manufacturing operation in which the "kneaded mixture" is leveled by passing the coated board between rollers (See Figure 3). The Examiner has admitted (Page 5) that Takaoka et al does not disclose a self-gauging composition, but the Examiner argues that "self-gauging" is merely an intended use. Although there is some merit to the examiner's position, applicants' claims define an aggregate with limitations not disclosed or made obvious by the prior art and the aggregate defined by applicant's claims is essential to produce the self-gauging property claimed by applicants. Accordingly the self-gauging property is not merely an intended use, but is the result of using the aggregate defined by applicants' claims.

Applicants would like to make of record the telephone interview between Examiner Callie Shosho and applicants' attorney, Donald E. Egan on February 21, 2003 in which the "intended use" issue was discussed. The Examiner was apprised that applicants had run tests on the prior art compositions that would be made of record in a Declaration and that a CPA would be filed.

Reconsideration of all grounds of rejection is respectfully requested in the light of the forgoing Remarks and the accompanying Declaration and an early Notice of Allowance is solicited.

Very truly yours,



Donald E. Egan

March 14, 2003